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09/324,182

06/02/1999

AMIT R. SHAH

2870/155

1161

26646

7590

04/24/2002

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NEW YORK, NY 10004

EXAMINER

PULLIAM, AMY E

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 04/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/324,182

Applicant(s)

SHAH ET AL.

Examiner

Amy E Pulliam

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1615

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Receipt is acknowledged of the Response, received February 4, 2002.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7-19, 21, 22, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,523,091 to Pastour *et al.* (hereinafter Pastour).

Pastour discloses a cosmetic emulsion composition which comprises a silicone, a gelling agent, and an emulsifying agent (abstract). Pastour teaches that the emulsifying agent can be dimethicone and mixtures thereof (c 1, l 45). Pastour further teaches that the silicone can be a cyclomethicone (c 3, l 18). Pastour also allows for additives such as vegetable oils such as jojoba oil, apricot oil, grape seed oil, and others (c 5, l 1-13), and he also includes surfactants (c 5, l 20), and pigments (c 5, l 44). Pastour also teaches that the composition can comprise active ingredients such as plant extracts, and these can be present from between 1 and 15%. Further, the cosmetic can contain fillers of plants, either inorganic or synthetic, such as starch or nylon (c 6, l 3-11). Lastly, Pastour teaches that his composition can be in the form of a mascara.

Applicant's arguments have been fully considered but are not found persuasive. In addition to the discussion stated in the non-final office action of October 10, 2001, the examiner sets forth the following concerns. Applicant argues that their invention contains a substantially whole processed fruit or vegetable extract. Applicant's asserts that this is not taught by the reference. Further, applicant argues that the constituents of the fruit or vegetable are not filtered. However, this specific claim limitation is not present in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Additionally, applicant argues that the whole fruit or vegetable can be ground, liquefied, pressed, or processed, however applicant's claims do not provide any specific limitations to the processing step. Although the claims are read in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The examiner is permitted to apply the broadest interpretation to the claims. Therefore, read broadly, the processing step can include the normal extract processing steps. Furthermore, although there is no evidence that the reference's extract is filtered, even if it was, the inclusion of the word processed in applicant's claims would still allow the reference to read on applicant's instant claims.

Applicant states that the processing techniques are well within the knowledge of one of ordinary skill in the art, and therefore do not need to be elaborated upon in the specification. The examiner respectfully disagrees. Applicant has submitted many

arguments and references explaining what extract is known to mean in the art. It remains the position of the examiner that when reading applicant's claim language, and trying to determine what is meant by processing steps, one of skill in the art would look to the typical steps known in the process of extraction.

Most importantly, the examiner finds the claim language to be confusing. The claim language states "substantially whole processed fruit or vegetable extract". The applicant is focusing on the "whole processed fruit or vegetable," while the examiner is focusing on the word "extract." The examiner suggests that applicant more clearly define the claim language to differentiate applicant's invention from a typical plant (fruit or vegetable) extract. Furthermore, the examiner suggests that applicant submit comparative data, in order to prove that the part of the fruit being used by applicant does indeed cause a different effect than the prior use of the typical extract.

As stated in the previous office action, the data present in the specification is not persuasive in showing unexpected results. It is the position of the examiner that there is no functional difference between applicant's claimed mascara and the mascara disclosed by Pastour. Specifically, on page 8 of applicant's specification, there is a discussion of a study using the claimed formulation. For each of the tested characteristics (natural appearance, comfort on the lashes, not causing lashes to be pointed, lack of clumping), 80% of the women said the mascara was equal to or better than their current mascara. This data can be interpreted to mean that 80% or more of the women thought the claimed formulation performed the same as the current

formulation, therefore rendering no unexpected results. Therefore, the above rejection is maintained.

In conclusion, the examiner recommends that the claims be amended to more clearly set forth what the invention is, and more clearly differentiate the differences between the present invention and the prior type of extracts. Additionally, the examiner recommends the submission of data to show unexpected results.

For the above reasons, the rejections are maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,523,091 to Pastour *et al.*. Pastour is discussed above as disclosing a cosmetic composition, which can be a mascara, and which can contain actives such as plant extracts. Pastour does not teach the specific percent of extract as claimed in claim 3. However, he does teach a very small and similar amount of extract. Further, Pastour does not teach the specific natural non-plant fiber as claimed by applicant. However, he does teach the inclusion of inorganic and synthetic fillers in general. Pastour does not teach the specific surfactant as claimed by applicant. It is the position of the examiner that the exact percent of the extract, the specific inorganic additives, and the specific

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surfactant are all limitations which would be routinely determined by one of ordinary skill in the art, as being suitable, based on the generic teachings in Pastour. Furthermore, the examiner reads the teaching of plant extract to include any and all plants, as Pastour does not differentiate. Therefore, this teaching includes both vegetables and fruits. One of ordinary skill in the art would have been motivated to make a mascara composition based on Pastour's teachings, which comprises any plant extract, and also contains inorganic or synthetic fillers and surfactants. The expected result would be a successful mascara composition, which has the beneficial qualities of Pastour's composition, which are ease of application, softness, uniformity, hold, and good sensory qualities. Therefore, this invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Applicant's arguments have been considered but are not found persuasive for the reasons stated above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy E Pulliam whose telephone number is 703-308-4710. The examiner can normally be reached on Mon-Thurs 7:30-5:00, Alternate Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

AEP
April 17, 2002

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600